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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,134	12/01/2003	Michael Perna	02262	2656
30114	7590	03/08/2006	EXAMINER	
MERONI + MERONI P.O. BOX 309 BARRINGTON, IL 60011			BALSIS, SHAY L	
			ART UNIT	PAPER NUMBER
			1744	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/725,134

**Applicant(s)**

PERNA ET AL.

**Examiner**

Shay L. Balsis

**Art Unit**

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/1/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election of 1-14 in the reply filed on 1/17/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 15-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on 1/17/06.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 6 and 11 rejected under 35 U.S.C. 102(b) as being anticipated by Wilson (USPN 5540363).

Wilson teaches a brush having a handle (upper 12 on figure 2), a shoulder portion (figure 2, portion connecting the handle and the bristles) and bristles (lower 12 on figure 2). There is a closed cell foam body (50) sized for floatation upon liquid in a container. The foam body comprises a flat bottom and top side along with one side wall perpendicular to the bottom side. There is an aperture (col. 4, lines 51-62) in the foam body for frictional engagement with the handle of the brush. Closed cell foam is known in the art as a material resilient to chemical solvent degradation.

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Claims 1-2, 6-8 and 11 rejected under 35 U.S.C. 102(b) as being anticipated by Couch et al. (USPN 5992617).

Couch teaches a brush having a handle, a shoulder portion and bristles (all the parts are shown on figure 6, however they are not labeled). There is a foam body (50, 60) sized for floatation upon liquid in a container. The foam body comprises a flat bottom and top side along with one side wall perpendicular to the bottom side. There are apertures (52, 62) in the foam body for frictional engagement with the handle of the brush. The apertures can comprise different sizes so as to frictionally engage brushes of different sizes (col. 3, lines 47-53). The foam material as taught by Couch is clearly resilient to chemical solvent degradation since is used in connection with paint thinners.

Claims 1-2, 6 and 11 rejected under 35 U.S.C. 102(b) as being anticipated by Steinarson (USPN 1696816).

Steinarson teaches a brush having a handle (4), a shoulder portion (6) and bristles (5). There is a sponge body (10) sized for floatation upon liquid in a container. The foam body comprises a flat bottom and top side along with one side wall perpendicular to the bottom side. There is an aperture (figure 3) in the foam body for frictional engagement with the handle of the brush. The sponge material of Steinarson is resilient to chemical solvent degradation since it is used closely with paint and paint thinners.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (USPN 5540363).

Wilson teaches all the essential elements of the claimed invention however fails to teach the exact dimensions of the foam body and its aperture. It would have been obvious to one of ordinary skill in the art to modify Wilson so that the foam body has a thickness from about 1 inch to 3 inches and that width of the body is about 3 inches to 5 inches as claimed. Additionally, it would have been obvious to modify the aperture so that it is about 9/16 inches to 11/16 inches as claimed. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. Since the Wilson would not perform differently with the claimed dimensions, the present invention is not patentably distinct from the prior art.

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Claims 3-5, 9-10, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Couch et al. (USPN 5992617).

Couch teaches all the essential elements of the claimed invention however fails to teach the exact dimensions of the foam body and its aperture. It would have been obvious to one of ordinary skill in the art to modify Couch so that the foam body has a thickness from about 1 inch to 3 inches and that width of the body is about 3 inches to 5 inches as claimed. Additionally, it would have been obvious to modify the aperture so that it is about 9/16 inches to 11/16 inches as claimed. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. Since the Couch would not perform differently with the claimed dimensions, the present invention is not patentably distinct from the prior art.

Claims 3-5, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steinarson (USPN 1696816).

Steinarson teaches all the essential elements of the claimed invention however fails to teach the exact dimensions of the foam body and its aperture. It would have been obvious to one of ordinary skill in the art to modify Steinarson so that the foam body has a thickness from about 1 inch to 3 inches and that width of the body is about 3 inches to 5 inches as claimed. Additionally, it would have been obvious to modify the aperture so that it is about 9/16 inches to 11/16 inches as claimed. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed.

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Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. Since the Steinarson would not perform differently with the claimed dimensions, the present invention is not patentably distinct from the prior art.

***Conclusion***

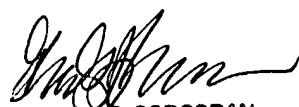
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shay L. Balsis whose telephone number is 571-272-1268. The examiner can normally be reached on 7:30-5:00 M-Th, alternating F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys Corcoran can be reached on 571-272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Slb  
2/23/06



GLADYS J.P. CORCORAN  
PRIMARY EXAMINER